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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,404	10/21/2003	Hiroki Moriyama	17136	5953

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SCULLY SCOTT MURPHY & PRESSER, PC  
400 GARDEN CITY PLAZA  
SUITE 300  
GARDEN CITY, NY 11530

EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/690,404

Applicant(s)

MORIYAMA, HIROKI

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 19, 2006 has been entered.

### ***Notice of Amendment***

In response to the amendment filed on May 22, 2006, amended claims 1 and 17 are acknowledged. The current rejections of the claims *stand*. The following reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,083,549 to Cho et al.

**In regards to claims 1 and 17**, Cho et al. disclose an endoscope comprising: an insertion unit having a soft portion, the soft portion including a small-diameter portion and a large-diameter portion; the large-diameter portion is formed on the operator side

of the soft portion opposite to the small-diameter portion and whose outer diameter is larger than the outer diameter of the small-diameter portion; and a tapered portion included in the soft portion linking the small-diameter portion (see Col. 5, Lines 60-67) and the large-diameter portion wherein at least part of the tapered portion being is separated 70 cm or less from a distal endoscope end (see Col. 2, Lines 28-45, Col. 3, Lines 13-23 and Fig. 2). Furthermore, Cho et al. teach that is well known in the art to use flexible ureteroscopes.

**In regards to claim 2**, Cho et al. disclose an endoscope, wherein to the small-diameter portion is long enough to be bent 180 degrees while forming an arc having a minimum radius (see Col. 6, Lines 46-56).

**In regards to claims 3-4**, Cho et al. disclose an endoscope, wherein at least part of the tapered portion is located forward an endoscope portion separated 45 cm from the distal end (see Fig. 5b)

Claims 5-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,083,549 to Cho et al. in view of U.S. Patent No. 5,084,022 to Claude.

**In regards to claims 5-16**, Cho et al. disclose an endoscope but are silent with respect to indices indicating distances from the distal end are inscribed on the soft portion. Claude teaches of an analogous medical apparatus provided with spaced indicia to indicate the distance the instrument is extended into a vascular vessel, catheter or other instrument (see Figs. 1-3). Furthermore the indices are capable of being formed on the instrument in any desired location considered to be helpful to the operator and the desired procedure. It would have been obvious to one skilled in the art

at the time the invention was made to include indices on the endoscope of Cho et al. in order to facilitate the determination of the distance an instrument extends into a cavity as taught by Claude.

### ***Response to Arguments***

Applicant's arguments filed May 22, 2006 have been fully considered but they are not persuasive.

Applicant states that Cho fails to disclose a tapered portion being separated 70cm or less from the distal end. However, <sup>Cho</sup> clearly discloses that the overall length of the shaft is 37-44 cm (see Col. 4, Line 19). Thus the tapered portion would have to be less than 70 cm from the distal end.

Applicant further states that Cho fails to disclose a soft portion having both a small-diameter and large-diameter portion with a tapered portion connecting the two. However, Cho discloses an endoscope that employs a main outer shaft which is preferably one-piece and which has an outside diameter that varies along its length and in particular decreases toward the distal end, either uniformly or in overlapping stages (see Col. 2, Lines 28-45).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

*Handwritten signature/initials*  
8/13/06

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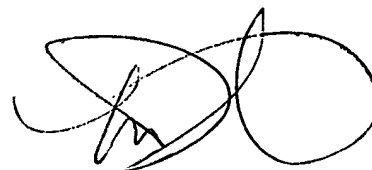
number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK



8/22/06



LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700